

### **REMARKS**

Claims 1-2 have been amended. Claims 5 and 9 stand cancelled from a previous paper as being drawn to non-elected subject matter. No new matter has been added by virtue of the within amendments; support therefor can be found throughout the specification and in the original claims of the application.

Claims 1-4 and 6-8 stand rejected under 35 USC §112, second paragraph. It is believed that the within amendments obviate the informalities which are the subject of the §112 rejection. Thus, withdrawal of the rejection is believed proper.

The final two rejections are discussed in combination as they relate to the same reference - Zimmermann et al. (WO 99/03854).

Claims 1, 2 and 6-8 stand rejected under 35 USC §102(b) over Zimmermann et al.

Claim 3 stands rejected under 35 USC §103(a) over Zimmermann et al.

The rejections are traversed. The cited reference fails to teach or suggest the present invention and cannot sustain either of the rejections under 35 USC §102(b) or §103(a).

Moreover, the claims of the application have been amended to further define and clarify the features of the invention. For instance, the amended claims recite compounds wherein when  $n=0$ ,  $R_9$  represents piperidine or 4-methylhomopiperazine (in order for  $R_9$  to represent 4-methylpiperazine,  $n=1$ ). Such compounds are clearly distinguishable from the compound (I) of Zimmermann et al.

Also, Zimmermann et al. reports a new crystalline form of imatinib mesylate (Gleevec®) and a process for the preparation of that crystalline form. Zimmermann et al. do not describe any concrete pharmacological effects of the new crystalline form. In contrast, the compounds of the present invention exhibit excellent and significantly superior pharmacological effects against the growth of various cancer cells as

compared to imatinib mesylate, further rebutting any *prima facie* case of obviousness that may be contended. (Attention is directed, for example, to the experimental data shown in Experiments 1-8 of the present application.)

The rejections are therefore properly withdrawn. See, for example, *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art."). Additionally, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143. These criteria are not met in the instant case.

Reconsideration and withdrawal of the §102(b) §103(a) rejections are therefore respectfully requested.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

Dated: May 3, 2006

Respectfully submitted,

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